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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,820

09/26/2003

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EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

04/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,820	Applicant(s) JONES, MICHAEL C.	
	Examiner JAMES L. SWIGER	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 14, 20-22, 24-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 14, 20-22, 24-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/22/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6, 14, 20-22, 24-27, 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 6, there is not support for the claimed subject matter directed to "including a conical portion." This limitation is also found in claim 14.

In claim 14, applicant also refers to this "conical" limitation. Additionally, in claim 14, applicant, in line 13, also appears to claim that the second and third components

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now have restraining portions. It appears that there is only support for them having "cooperating portions" and not restraining portions as the line now appears to read.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 27, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wack (EP 0992225 A2).

Wack discloses an instrument for compacting bone having a first component (82) that defines a longitudinal axis and a body which has an outer periphery and is also tapered along the longitudinal axis (see section that enters into the intramedullary of the canal). Wack also discloses components which could be second and third components (see alternating panels 80 shown in Fig. 1) which are slidably mounted onto the first component. The components are also tapered. Wack also discloses a restraining portion on the first component, which is considered the flattened surface on the side 60. Alternatively, there is a similar surface on the other side. The matching face of the 2nd and 3rd components are considered the cooperating portions which interact with the first component. The one of the first component also comprises a groove (see trapezoidal shaped groove 62) into which a protrusion extends from the third component (70). These modifications help to keep the device in alignment and to aid in compacting the bone in use. The two portions are capable of moving relative to one another, and in

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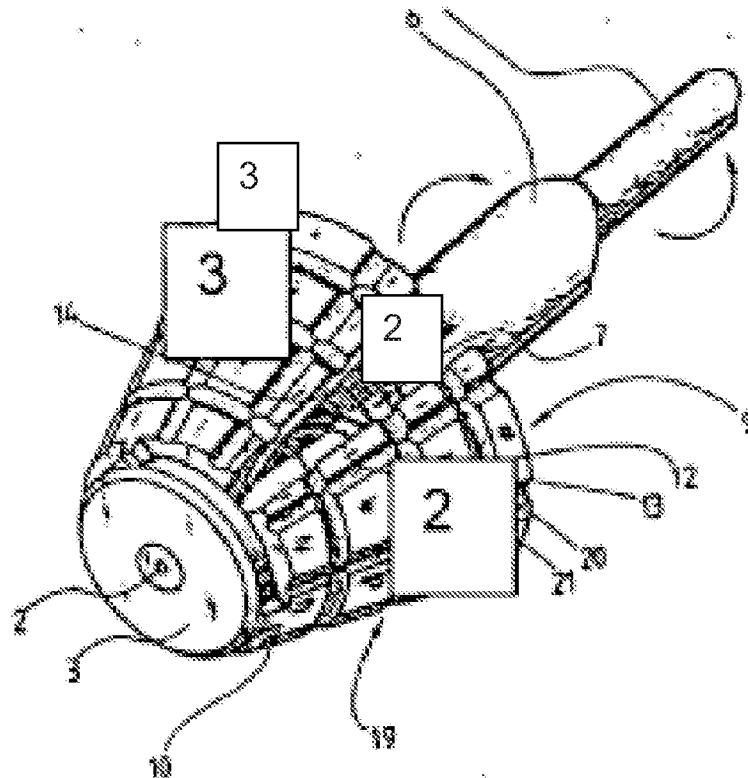
addition to the bores in between the two portions are capable of creating a space or opening depending on how each is actuated or moved.

Wack discloses the claimed invention except for the tamp having a conical shape. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tamp having a specific conical shape, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of forming in bone an appropriate cavity for a prosthetic to be installed. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 6, and 20-22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parhofer et al. (For Pat DE3630069) in view of Termanini (US Patent 4,237,875).

Parhofer et al. disclose a device having a first component defining a longitudinal axis (see Fig. 3, item 1), and a second component (19) movably associated with the first component (see joint at 10) in a radial direction (Fig. 2) and are separable by the an opening. The device further has a body (Fig. 3), and a stem extending from said body (6), and wherein the second component is tapered (Fig. 1). The device also has a restraining portion (8) and a cooperating portion of the second component (10) to provide restrained motion. The device also has a third component moveably associated with the first component (See Fig. 2 below, and the section denoted as "3" is the third component).

Fig. 2



Further, the internal side of component 2 has a surface associated with the first component (on the inside) while the second component has a surface capable of contact with bone material and that is also capable of urging the particles radially (see Col. 2 through Col. 3). The device also provides for a motion of the second component away from the longitudinal axis of the first component as the first component is advanced axially (Col. 5, lines 41-63).

Parhofer et al. disclose the claimed invention except for a groove and protrusion that helps to regulate the actuation between the moveable components. Termanini teaches an instrument that is capable of compressing bone with components that interact with a groove (3) and protrusion (8) see Figs. 3 and 4. They are considered to have sliding movement with respect to one another. It would be an obvious modification

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to have multiple components as taught by Parhofer et al. See also Col. 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Parhofer et al. having at least the grooves and protrusion in view of Termanini to have improved actuation when compacting bone.

Parhofer et al. and Termanini disclose the claimed invention except for a first component having a conical portion. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tamp having a specific conical shape, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of forming in bone an appropriate cavity for a prosthetic to be installed. In re Dailey and Eilers, 149 USPQ 47 (1966).

Response to Arguments

Applicant's arguments with respect to claims 6, 14, 20-22, 24-26, 29-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER whose telephone number is (571)272-5557. The examiner can normally be reached on M-F, 9am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L. SWIGER/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775